

# Notice of Allowability

Application No.

10/724,731

Examiner

Janet L. Coppins

Applicant(s)

HASSILA ET AL.

Art Unit

1626

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicants' Amendment of December 22, 2004.
2. ☒ The allowed claim(s) is/are 1 and 4.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

## DETAILED ACTION

Claims 1 and 4 are pending in the instant application.

### *Information Disclosure Statement*

1. Receipt is acknowledged of Applicant's Information Disclosure Statement, filed December 2, 2003, which has been considered by the Examiner. Please refer to Applicant's copy of the PTO-1449 form submitted herewith.

### *Election/Restrictions*

2. Applicant has previously elected **with traverse** the invention of Group I, claim I, directed to a chiral phosphine compound of formula (1).
3. Examiner Waller indicated in the Office Action of September 22, 2004 that claim 1 was allowable over the prior art. Therefore, in accordance with MPEP 821.04 and *In re Ochiai*, 71 F. 3d 1565, 37 USPQ 1127 (Fed. Cir, 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Rejoinder is permitted when the withdrawn process claims depend from or otherwise include all limitations of the allowed product claim.
4. Therefore, claim 4, drawn to a process of preparing a chiral phosphine compound of formula (1), is herein rejoined for prosecution.

In view of the above noted withdrawal of the restriction requirement as to the linked product and process, Applicants are advised that if any claim(s) depending from or including all the limitations of the allowable product claim be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double

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patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

#### EXAMINER'S AMENDMENT

5. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. John W. Bailey, Reg. No. 32,881, on March 17, 2005.

The application has been amended as follows:

(a) Claim 4, page 4, line 7 (which is the 5th line of text following the illustration of formula 1), please delete "an aryl or" and replace with "a" so that the line now reads, "a heteroaryl group, which may be substituted,"

(b) Claim 4, page 4, line 9 (which is the 7th line of text following the illustration of formula 1), please delete in its entirety, "a saturated hydrocarbon group, which may be substituted,"

#### *Allowable Subject Matter*

6. Claims 1 and 4 are allowable. The following is an examiner's statement of reasons for allowance:

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This invention relates to novel chiral phosphine compound, as well as a processes of preparing it. The instant application is a Divisional of U.S. Application No. 10/097,009, which has been found allowable, and is now U.S. Patent No. 6,762,306 B2. Azetidine-metal complexes are known in the art as efficient transition metal complex catalysts, and various methods of preparing the above-mentioned compounds are known. However the instant claimed compounds according to formula (1), wherein the alkyl chain off of the azetidine ring is disubstituted, are novel and unobvious. The allowable subject matter in this case is limited to compounds as well as a process for preparing said compounds according to formula (I), of claims 1 and 4. The closest prior art of record, Pasquier et al., teach similar amino-phosphine ligands as catalysts, and their process of preparation. However, Pasquier et al. fail to teach or render obvious the same azetidine-phosphine compounds as instantly claimed, since the alkyl chain off of the azetidine ring is disubstituted in the instant claims, and do not fairly suggest their processes of preparation.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### *Telephone Inquiry*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins  
March 17, 2005

  
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